

20 CV 8730

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

GARY GONZALEZ, an individual,

Plaintiff,

v.

Civil Action No.

COALITION TO ADVANCE THE
PROTECTION OF SPORTS LOGOS
d/b/a CAPS, and
NEW ERA CAP CO., INC.

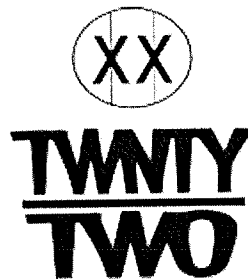
Defendants.

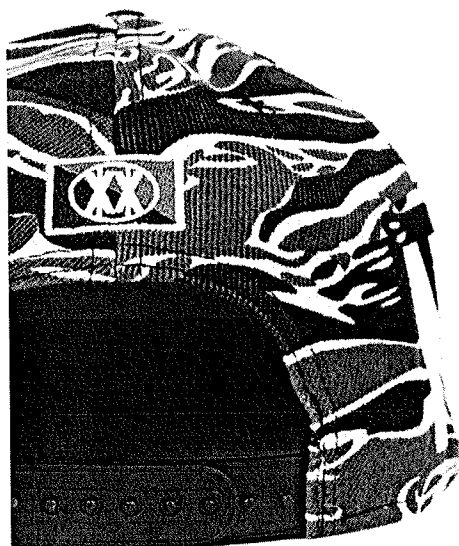
COMPLAINT FOR DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF
TRADEMARK AND TEMPORARY AND PERMANENT INJUNCTION

Plaintiff, Gary Gonzalez, alleges his complaint against Defendants, Coalition to Advance the Protection of Sports Logos d/b/a CAPS, and New Era Cap Co., Inc. ("New Era") as follows:

INTRODUCTION

1. Plaintiff is the owner of an independent headwear business that designs, manufactures and sells caps and other headwear items under the brand name **XX TWNTY TWO®** as shown in the images below:







JURISDICTION AND VENUE

2. Jurisdiction over the claims, which are seeking a declaratory judgment, are brought pursuant to the Federal Declaratory Judgment Act, 28 U.S.C §§ 2201 *et seq.* Jurisdiction in this Court is also proper as this Complaint concerns matters having exclusive federal jurisdiction, including the Trademark Act of 1946, as amended, 15 U.S.C. §1051 *et seq.* and 28 U.S.C. §1367.

3. This Court has personal jurisdiction over the Defendants' because Defendant New Era Cap Co., Inc. and Defendant CAPS engage in continuous and significant business activities in and directed to the State of New York within this judicial district.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and (c) because it is where Plaintiff resides and the Defendants transacts business in this district, and because a substantial portion of the events giving rise to the asserted claims have occurred, and

continue to occur, within this district. Furthermore, the damage to Plaintiff and its intellectual property and business interruption described herein continues to occur in this judicial district.

THE PARTIES

5. Plaintiff, Gary Gonzalez is an individual with an address at 60 East 104th Street, #3E, New York, NY 10029.

6. Upon information and belief, Defendant Coalition to Advance the Protection of Sports Logos d/b/a CAPS is a business and unincorporated association located at 122 E. Popular Avenue, Coeur D' Alene, ID 83814.

7. Upon information and belief, Defendant New Era Cap Co., Inc., is a New York corporation with a principal place of business at 160 Delaware Avenue, Buffalo, New York 14202.

FACTS

8. Plaintiff Gary Gonzalez is the owner of United States Trademark Registration No. 4,916,926 for the mark **XX TWNTY TWO®** for headwear. (See Exhibit A attached.)

9. Plaintiff Gary Gonzalez manages and operates an online headwear business via the website www.twntytwo.com.

10. Plaintiff's **XX TWNTY TWO®** brand headwear products enjoy a superlative reputation in the headwear industry.

11. All of Plaintiff's headwear products are uniquely identified with Plaintiff's **XX TWNTY TWO®** brand including but not limited to Plaintiff's product hangtags, product packaging labels, private sewn woven labels and Plaintiff's products are even embroidered with his **XX TWNTY TWO®** registered trademark.

12. On August 5, 2020, Defendant CAPS sent Plaintiff a Cease-and-Desist letter via email alleging trademark infringement. **(See Exhibit B attached.)**

13. On August 5, 2020, Defendant New Era sent Plaintiff a Cease-and-Desist letter alleging trademark infringement of its various trademarks. **(See Exhibit C attached.)**

14. On August 21, 2020, Plaintiff's business manager responded to New Era's letter and advised New Era that its allegations of infringement were misplaced.

15. On August 25, 2020, Defendant CAPS sent Plaintiff a follow-up Cease-and-Desist letter via email alleging trademark infringement and threatening legal action against and the reporting and removal of Plaintiff's accounts and websites used to operate his business purportedly because of Plaintiff's infringement on CAPS Members trademarks. **(See Exhibit D attached.)**

16. On September 4, 2020 Plaintiff's business manager sent Defendants CAPS a response to its infringement claims.

17. On October 2, 2020 and October 14, 2020, Defendant CAPS sent Plaintiff additional emails still alleging infringement of its CAPS Members marks and New Era's marks and threatened to take further action against Plaintiff.

18. Plaintiff alleges that he has not been utilizing the CAPS Members Marks and/or Defendant New Era's Marks.

19. Plaintiff alleges that all of his headwear designs are original and do not copy the designs or logos of the Defendants.

FIRST CLAIM FOR RELIEF
DECLARATORY RELIEF OF NON-INFRINGEMENT OF TRADEMARK

20. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 19 of this Complaint.

21. Plaintiff alleges that his headwear products are uniquely identified and branded with Plaintiff's own **XX TWNTY TWO®** mark.

22. Plaintiff disputes the allegation that Plaintiff actions in selling headwear under his own registered trademark constitutes infringement of any trademark rights owned by Defendants CAPS or New Era.

23. Plaintiff alleges that Defendant CAPS and Defendant New Era have not had any instances of actual confusion in regards to the use of Plaintiff's designs placed on his headwear products.

SECOND CLAIM FOR RELIEF
PRELIMINARY AND PERMANENT INJUNCTION

24. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 23 of this Complaint.

25. Defendant CAPS and New Era have threatened specific actions intended to interfere with Plaintiffs business.

26. Any such specific actions by Defendants are in violation of Plaintiff's rights.

27. Plaintiff alleges he is entitled to an immediate and permanent injunction precluding Defendants CAPS and New Era from interfering with his business.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully prays for relief as follows:


1. Plaintiff be granted a Declaratory Judgment of Trademark Non-Infringement with regard to Defendants allegations of trademark infringement.
2. Plaintiff be granted an immediate and permanent injunction preventing Defendants from interfering with Plaintiff's business

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff hereby demands a trial by jury as to all issues.

Dated: October 19, 2020
New York, New York

Respectfully submitted,
Gary Gonzalez – Pro Se

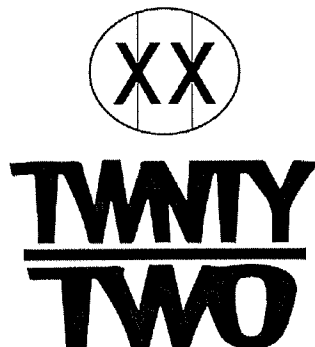


Gary Gonzalez
Pro Se Plaintiff
60 East 104th Street – Suite #3E
New York, New York 10029
(646) 938-8388

EXHIBIT A

United States of America

United States Patent and Trademark Office



Reg. No. 4,916,926

Registered Mar. 15, 2016

Int. Cl.: 25

TRADEMARK

PRINCIPAL REGISTER

THOMAS, DATWON (UNITED STATES INDIVIDUAL)
9021 216TH STREET
QUEENS VILLAGE, NY 11428 AND

GONZALEZ, GARY (UNITED STATES INDIVIDUAL)
9021 216TH STREET
QUEENS VILLAGE, NY 11428 AND

ROGERS, SADE (UNITED STATES INDIVIDUAL)
9021 216TH STREET
QUEENS VILLAGE, NY 11428

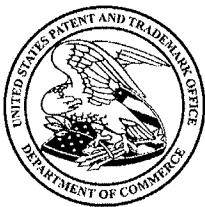
FOR: HEADWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 1-1-2013; IN COMMERCE 1-1-2013.

THE MARK CONSISTS OF THE STYLIZED WORDING "XX" PLACED WITHIN AN OVAL SHAPE, WITH VERTICAL LINES RUNNING THROUGH EACH "X". BENEATH THE OVAL IS THE WORDING "TWNTY" ABOVE "TWO" WITH A HORIZONTAL LINE PLACED BETWEEN THE TWO WORDS.

SER. NO. 86-471,335, FILED 12-4-2014.

ERIC SABLE, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

EXHIBIT B



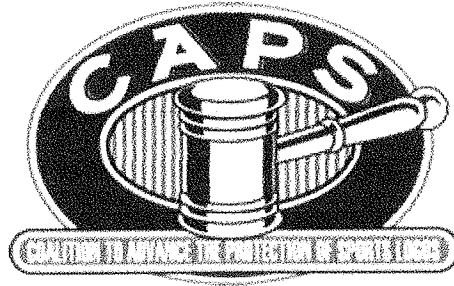
Twntytwo Customer service <twntytwocs@gmail.com>

Unauthorized Use of the CAPS Members' Trademarks**Nikkie Johnson** <nikkiej@trademarkmanagement.com>

Wed, Aug 5, 2020 at 11:10 AM

To: "twntytwocs@gmail.com" <twntytwocs@gmail.com>

Cc: Cortney Martin <cortneym@trademarkmanagement.com>, Lindsay Conn <lindsayc@trademarkmanagement.com>



122 E. Poplar Avenue

Coeur d'Alene, ID 83814

208-292-1010

August 5, 2020

VIA ELECTRONIC AND CERTIFIED MAIL**RETURN RECEIPT REQUESTED**

Twnty-Two

Gary Gonzalez

1734 Townsend Ave, Apt 17B

Bronx, New York 10453

twntytwocs@gmail.com

Re: Unauthorized Use of the CAPS Members' Trademarks

Dear Mr. Gonzalez:

This letter is sent on behalf of the members of the Coalition to Advance the Protection of Sports logos ("CAPS"), namely, Collegiate Licensing Company, LLC; Major League Baseball Properties, Inc.; NBA Properties, Inc.; NFL Properties LLC and NHL Enterprises, L.P. (collectively, the "CAPS Members"). The CAPS Members are the owners of, and/or are responsible for the licensing and protection of, the names, trademarks, copyrights, symbols, emblems, designs, logos, photographs, uniforms, team colors and identification of their respective teams, organizations and collegiate institutions (the "Marks"). For your reference, some of the Marks include, but are not limited to, those shown in Exhibit A.

Based on the foregoing rights, no one may manufacture, distribute, offer to sell and/or sell any products bearing the Marks unless the products are made under a license from, or the express written consent of, the CAPS Members or their respective teams, organizations or collegiate institutions. No party may make any other commercial use of the Marks without such license or consent.

You are manufacturing, advertising, distributing, selling and/or offering for sale unauthorized merchandise bearing the Marks of one or more of the CAPS Members in violation of state and federal laws.

Your unauthorized use of the CAPS Members' Marks constitutes trademark infringement and unfair competition in that purchasers of these products will erroneously believe that such merchandise is licensed, sponsored or authorized by the CAPS Members. In addition, your use of the Marks dilutes the distinctiveness of the CAPS Members' Marks by trading upon the goodwill and reputation that the public associates with their Marks. It also interferes with the merchandising and licensing of their Marks.

The CAPS Members demand you and every person and/or company affiliated with you immediately and permanently discontinue the manufacturing, advertising, distributing, selling, and/or offering for sale of any such unauthorized merchandise bearing the Marks of the CAPS Members. In addition, you must advise us, in writing, of your compliance with the foregoing and furnish us with the following within ten (10) days.

- a. A complete and accurate accounting of all unauthorized merchandise bearing the CAPS Members' Marks sold by you, including sales dates and prices, to determine damages;
- b. Confirm that you are the manufacturer of the unauthorized merchandise described. If you are not the manufacturer, please provide the name, address, and telephone number of the manufacturer and/or supplier of the unauthorized items;
- c. The names and addresses of the owners and/or officers of your business and/or any affiliated company or business; and,
- d. Surrender any remaining inventory of unauthorized merchandise utilizing the CAPS Members' Marks to our office.

A form for the required information has been attached.

If you do not agree to the points set forth above, the CAPS Members will have no choice but to take further action against you, as is necessary to protect the CAPS Members' valuable intellectual property rights. The statement of facts in this letter is not intended to be, nor shall it be deemed to be, a full and complete statement of the facts. Nor is this letter intended to be a complete statement of the CAPS Members' rights and shall not be construed as a waiver of any legal or equitable rights or remedies, which are reserved.

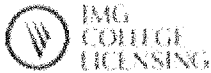
Sincerely,

/s/:CAPS Administrator

Attachment

cc: CAPS Members

Ref: Twnty-Two/nj



Notice: The information in this email and any attachment(s) is confidential and only for the intended recipient. If you are not the intended recipient, please delete this message and notify sender by return email. Any disclosure, copying or distribution of this email message by an unintended recipient is prohibited and may be unlawful. Trademark Management, LLC is not a law firm and does not provide legal counsel in any capacity. Information within this email does not constitute legal advice. The recipient is encouraged to consult its own legal counsel regarding the recipient's intellectual property and other rights.

2 attachments



Exhibit A.pdf
6321K



C&D Response Form.pdf
145K

EXHIBIT C



Harter Secrest & Emery LLP

ATTORNEYS AND COUNSELORS

WWW.HSELAW.COM

August 5, 2020

VIA EMAIL AND FEDEX

Mr. Gary Gonzalez
Twnty-Two, Inc.
1734 Townsend Ave, Apt. 17B
Bronx, New York 10453

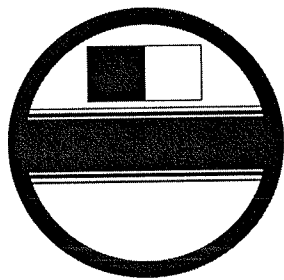
Mr. Gary Gonzalez
c/o Worldwide Brand Solutions
230 Clinton Street - Suite 11C
New York, New York 10002

Re: Infringement and Unauthorized Use of New Era Cap,
Major League Baseball and National Basketball Association
Trademarks and Trade Dress

Dear Mr. Gonzalez:

This firm represents New Era Cap Co., Inc. ("New Era") with respect to trademark matters. New Era is a global sports headwear and apparel designer and manufacturer, making more than 60 million licensed and non-licensed caps per year. New Era is the exclusive manufacturer and marketer of Major League Baseball's official on-field uniform caps, and a sampling of New Era's more than 400 other licenses include the National Football League, the National Basketball Association, the National Hockey League, Arena Football, and hundreds of colleges and universities.

New Era is the owner of the famous NEW ERA mark and the New Era Visor Sticker marks below, which are subject of numerous U.S. and international trademark registrations:



(United States Reg. No. 4,289,525)

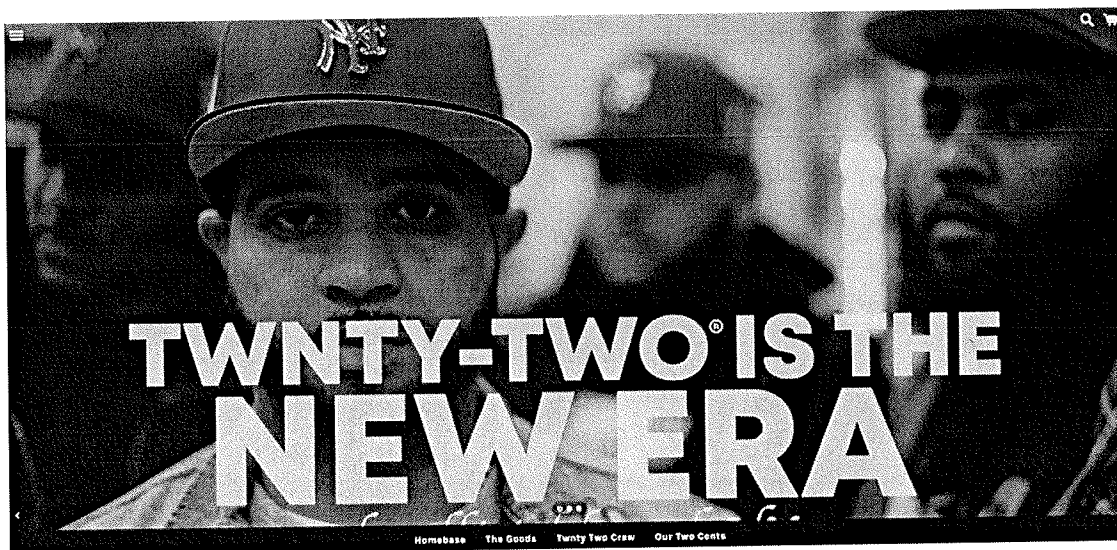


(United States Reg. No. 3,122,529)

August 5, 2020
Page 2

As a result of substantial sales and extensive advertising and promotion for many years, New Era's trademarks have become famous, and the marks are widely and favorably known throughout the world as a unique identifier of products manufactured or sold by, or associated exclusively with New Era.

We recently learned that Twnty Two is intentionally and brazenly infringing and diluting New Era's famous NEW ERA mark and visor sticker mark as in the examples below:



August 5, 2020

Page 3



Your use of the famous NEW ERA mark, together with these obviously copied visor stickers confirms your attempt to intentionally trade on New Era's substantial goodwill; and your bad faith use of New Era's intellectual property will dilute New Era's famous marks, and will cause confusion in the marketplace.

It is also important for you to understand that any use of Major League Baseball or National Basketball Association logos or trademarks requires a license, that MLB is aware of your infringing use, and that MLB and the NBA vigorously enforce their trademarks. Both leagues are aware of your infringing use.

Your actions undeniably constitute trademark infringement in violation of the Lanham Act, 15 U.S.C. § 1114(1); unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); trademark dilution in violation of the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c); and violations of state common law. Federal and state law provide numerous remedies for your violations including, but not limited to, preliminary and permanent injunctive relief, money damages, your profits and, where willful infringement is shown, as is clearly the case here, attorneys' fees and treble damages.

In view of the foregoing, we demand that you *immediately* (a) discontinue any and all use of the NEW ERA mark and infringing visor sticker, and any other trademark or logo which infringes or mimics any New Era trademark; (b) discontinue any and all use of any MLB and NBA trademarks or logos, including without limitation the modified Yankees and Lakers marks above; (c) destroy all inventory of caps and other products which bear the visor sticker mark and any other trademark or logo which infringes or mimics any New Era trademark; (d) destroy all inventory of caps and other products which bear any MLB or NBA trademark or logo; (e) provide us with a sworn statement and images which demonstrate that you have complied with (c) and (d) above; (f) remove all infringing trademarks, MLB and NBA logos and trademarks, and corresponding products from your website, social media and all outlets through which your products are sold; and (g) withdraw your trademark application for TWNTY-TWO IS THE NEW ERA! (Serial No. 90016232).

August 5, 2020

Page 4

We further demand that you provide us with a complete accounting of all products Twnty Two has sold bearing the infringing visor sticker and/or any MLB or NBA logos or trademarks, and the number of each product you still have in inventory.

Please confirm on or before **August 12, 2020** that you will agree to these demands, or New Era will take legal action. This letter is sent without prejudice to New Era's rights, claims and remedies, all of which are expressly reserved.

Very truly yours,

Harter Secrest & Emery LLP

s/ Michael J. Berchou

Michael J. Berchou
DIRECT DIAL: 716.844.3753
EMAIL: MBERCHOU@HSELAW.COM

EXHIBIT D



Twntytwo Customer service <twntytwocs@gmail.com>

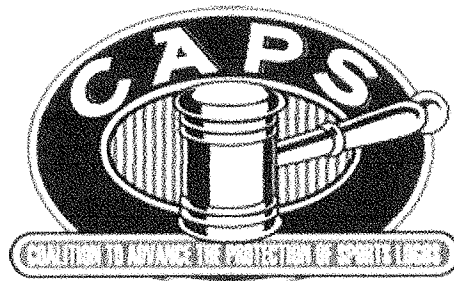
Unauthorized Use of the CAPS Members' Trademarks

Nikkie Johnson <nikkiej@trademarkmanagement.com>

Tue, Aug 25, 2020 at 11:33 AM

To: "twntytwocs@gmail.com" <twntytwocs@gmail.com>

Cc: Cortney Martin <cortneym@trademarkmanagement.com>, Lindsay Conn <lindsayc@trademarkmanagement.com>



122 E. Poplar Avenue

Coeur d'Alene, ID 83814

208-292-1010

August 25, 2020

Twnty-Two

Gary Gonzalez

1734 Townsend Ave, Apt 17B

Bronx, New York 10453

twntytwocs@gmail.com

Re: Unauthorized Use of the CAPS Members' Trademarks

Dear Mr. Gonzalez:

This letter is a follow up to our cease and desist letter sent to you on August 5, 2020 (copy below) regarding your unauthorized use of the CAPS Members' trademarks. To date, we have not

received a response from you, and you are continuing to sell and/or offer for sale unauthorized merchandise bearing the CAPS Members' trademarks.

To amicably resolve this matter, all unauthorized use of the CAPS Members' trademarks must cease immediately and a comprehensive written response to our initial letter must be received in our office by September 8, 2020. Failure to comply may result in further action being taken by the CAPS Members, including but not limited to, reporting for removal any online accounts/websites used by you to infringe their trademarks.

Your cooperation is anticipated.

Sincerely,

/s:/Nikkie Johnson
CAPS Administrator

cc: CAPS Members

Ref: Twnty-Two/nj



Notice: The information in this email and any attachment(s) is confidential and only for the intended recipient. If you are not the intended recipient, please delete this message and notify sender by return email. Any disclosure, copying or distribution of this email message by an unintended recipient is prohibited and may be unlawful. Trademark Management, LLC is not a law firm and does not provide legal counsel in any capacity. Information within this email does not constitute legal advice. The recipient is encouraged to consult its own legal counsel regarding the recipient's intellectual property and other rights.

© 2006 The Authors
Journal compilation © 2006 Blackwell Publishing Ltd

3/3